

Appl. No. 10/716,506
Amendment dated: February 17, 2007
Reply to OA of: August 17, 2006

REMARKS

Applicants have amended the claims to more particularly define the invention taking into consideration the outstanding Official Action. Applicants have amended claims 1 and 15 to add the limitation from the (a) portion of claim 8 and have canceled claims 5-8 from the present application. Applicants reserve their right to file a continuation application at a later time. Applicants submit that the amendments to the claims is fully supported by the specification as originally filed and no new matter has been introduced. Applicants most respectfully submit that all of the claims now present in the application are in full compliance with 35 USC 112 and are clearly patentable over the references of record.

The rejection of claims 1-16 under 35 U.S.C. 112, first paragraph for the reasons set forth in the outstanding Official Action has been carefully considered but is most respectfully traversed in view of the amendments to the claims. Applicants have incorporated the limitation of claim 8, section (a) into claim 1 in view of the Examiner's helpful suggestion and it is believed that this amendment obviates the outstanding rejection. Applicants further submit that the restriction to the Herbs limits the necessary experimentation with the disclosure and the specification is fully enabling for the full scope of the claims now present in the application without undue experimentation. Accordingly, it is most respectfully requested that this rejection be withdrawn.

Applicants most respectfully submit that all of the claims now present in the application are in full compliance with 35 USC 112 and clearly patentable over the references of record.

The rejection of claims 1-16 on the ground of nonstatutory obviousness-type double patenting as unpatentable over claims 1-7 of U.S. Patent No. 6,676,975 has been carefully considered but is most respectfully traversed. A terminal disclaimer is concurrently filed herewith by Applicants along with the required fee. It is most respectfully requested that this rejection be withdrawn.

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The rejection of claims 1-16 on the ground of nonstatutory obviousness-type double patenting as unpatentable over claims 1-11 of U.S. Patent No. 6,399,112 has been carefully considered but is most respectfully traversed. A terminal disclaimer is filed concurrently herewith by Applicants along with the required fee and it most respectfully requested that this rejection be withdrawn.

The rejection of claims 1-6 and 10-16 under 35 USC 102(b) as being anticipated over Castleman has been carefully considered but is most respectfully traversed in view of the amendments to the claims and further in view of the following comments.

Applicants submit that the possibility of therapeutic use of a decoction of *Radix Glycyrrhiza* (translation: licorice root) alone is no longer covered by the claims. The other potential "singular subset" rejections suggested by the Examiner in the final sentence of the rejection discussion are, of course, also overcome. Moreover, the limitation from claim 8, which was not included in this rejection, has been added to claims 1 and 15, thereby obviating the rejection. Accordingly, it is most respectfully requested that this rejection be withdrawn.

The rejection of claims 1-16 under 35 USC 103(a) as being unpatentable over Sheehan and Whittle has been carefully considered but is most respectfully traversed in view of the amendments to the claims and further in view of the following comments.

Applicants wish to direct the Examiner's attention to the basic requirements of a *prima facie* case of obviousness as set forth in the MPEP § 2143. This section states that to establish a *prima facie* case of obviousness, three basic criteria first must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Section 2143.03 states that all claim limitations must be taught or suggested by

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the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicants also most respectfully direct the Examiner's attention to MPEP § 2144.08 (page 2100-114) wherein it is stated that Office personnel should consider all rebuttal argument and evidence presented by applicant and the citation of *In re Soni* for error in not considering evidence presented in the specification.

In view of the amendment to claims 1 and 15, the present application is in essentially the same position on obviousness as the prior applications now US Patents 6399112 and 6676975.

The presently claimed invention is the use of a specific three-herb group to make a decoction/extract having beneficial therapeutic efficacy. The decoction/extract can be made via **individual** decoctions/extracts of the stated herbs which are then (or their dried residues) blended to form the active composition, or via decocting/extracting a **mixture** of the stated herbs to yield the active composition directly (cf claims 1 and 15). The **specific three-member** group is, of course, significantly reduced from the prior art ten-member set, and represents one of the specific groups for which essential maintenance of the efficacy in comparison with the ten-member set is proved in Table II of the application.

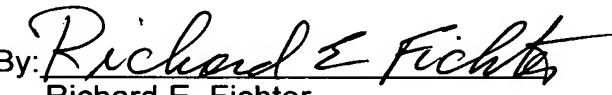
Moreover, it is the case in Chinese (and other) traditional herbal medicine that practitioners are very reluctant to depart from the traditional recipe. This is because the recipe has evolved by continuous gradual use-based refinement over many years or centuries, and is closely associated with the underlying theoretical basis for the medicine which is quite different from the essentially biochemical basis of western medicine. Traditional medicine generally uses underlying theoretical bases which involve a relatively holistic approach, taking into account mood, personality, general health, life-force and quasi-spiritual aspects.

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Applicants submit that it is not obvious to adjust the prior art in the way the present inventors have done, to maintain the efficacy of the composition. This position is confirmed by the prior grant of US Patents 6399112 and 6676975. Accordingly, it is most respectfully requested that this rejection be withdrawn.

In view of the above comments and further amendments to the claims, favorable reconsideration and allowance of all the claims now present in the application are most respectfully requested.

Respectfully submitted,
BACON & THOMAS, PLLC

By: 
Richard E. Fichter
Registration No. 26,382

625 Slaters Lane, Fourth Floor
Alexandria, Virginia 22314
Phone: (703) 683-0500
Facsimile: (703) 683-1080
REF/cjw
A01.wpd
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